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OFFICE OF PETITIONS

In re Application of :
Shen et al. :
Application No. 10/636,008 : DECISION
Filed: August 7, 2003 : ON PETITION
Attorney Docket No. BP3018 :
:

This is a decision on the "PETITION UNDER 37 C.F.R. § 1.78(a)(3) FOR ACCEPTANCE OF UNINTENTIONALLY DELAYED CLAIM FOR PRIORITY UNDER 35 U.S.C. § 120," filed August 25, 2004, to accept an unintentionally delayed claim under 35 U.S.C. 120 for the benefit of priority to prior-filed nonprovisional Application no. 10/264,486. For the reasons set forth herein, this petition is also being treated as a petition to accept an unintentionally delayed claim under 35 U.S.C. 119(e) for the benefit of provisional application No. 60/384,698, as set forth in the concurrently filed amendment.

The petition is granted.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii) respectively. In addition, the petition under 37 CFR 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

(1) the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR 1.78(a)(2)(i) and

1.78(a)(5)(i) of the prior-filed application(s), unless previously submitted;

(2) the surcharge set forth in § 1.17(t); and

(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The instant nonprovisional application was filed on August 7, 2003, and was pending at the time of the filing of the instant petition. Applicants acknowledge that the priority claim submitted on original filing was not in compliance with 35 U.S.C. § 120 and 37 C.F.R. § 1.78(a)(2). (The reference failed to state the relationship of application No. 10/264,486 to the instant application).

Moreover, a claim for priority to provisional application No. 60/384,698 was submitted on original filing. However, the claim was not perfected. Given the improper claim to application No. 10/264,486, the claim for priority to the provisional application could not be entered. Application No. 10/264,486 was a necessary intermediate application in the chain to satisfy the requirement that provisional application No. 60/384,698 not have been filed more than one year prior to the filing of a nonprovisional application that claims benefit to the provisional application.

On petition, references to the prior-filed nonprovisional and the prior-filed provisional application have been included in an amendment¹ to the first sentence of the specification following the title, as required by 37 CFR 1.78(a)(2)(iii) and 1.78(a)(5)(iii). This amendment was filed with this petition on August 25, 2004. The petition includes payment of the surcharge under § 1.17(t). Petitioner states that "the entire delay between the date the claim was due under 37 C.F.R. 1.78(a)(1)(ii) and the date the claim was filed (i.e., brought into compliance in this filing) was unintentional."

¹ This amendment is acceptable despite the inclusion of an incorporation by reference statement, because the application as filed included a statement incorporating by reference prior application No. 10/264,486.

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional application and prior-filed provisional application is submitted after expiration of the periods specified in 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii) respectively. Also, the references to the prior-filed applications were submitted during the pendency of the instant nonprovisional application. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional application satisfies the conditions of 37 CFR 1.78(a)(3) and 1.78(a)(6), the petition is granted.

The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) and 1.78(a)(6) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed applications. In order for the instant application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. §§ 120 and 119(e) and 37 CFR 1.78(a)(1) and (a)(2), and 1.78(a)(4) and (a)(5) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider these benefit claims and determine whether the instant application is entitled to the benefit of the earlier filing date.

This application is being forwarded to Technology Center Art Unit 2133 for consideration by the Examiner of applicant's claim under 35 U.S.C. §§ 120 and 119(e), and 37 CFR 1.78(a)(1) and (2) and 1.78(a)(4) and (5) for the benefit of priority to the prior-filed applications.

Telephone inquiries concerning this matter should be directed to Senior Petitions Attorney Nancy Johnson at (571) 272-3219.



Charles A. Pearson
Director
Office of Petitions